DETAILED ACTION

Election/Restrictions

1. Applicant's election of group I, comprising polyester derived from adipic acid and 1,4-butanediol as ultimate species of polyester in the reply filed on May 02, 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 16-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 02, 2008.

3. Claims 7-13 are withdrawn from present consideration as being drawn to a non-elected polyester species.

Claim Rejections - 35 USC § 102/103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-6, 14 and 15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over DE 10027905.

DE '905 discloses biodegradable molding compositions comprising a biodegradable polymer. Suitable biodegradable polymers include aliphatic polyester amides having a weight average molecular weight of up to 100,000. The polyester and polyamide components are aliphatic and meet the corresponding components of the present claims (pages 3-4, examples, claims).

Polyesteramides meeting the requirements of the present claims in terms of the types of polyester and polyamide components and molecular weight are embraced by the reference and would have been immediately envisaged to one having ordinary skill in the art. Given the similarity in chemistry, molecular weights and preparatory processes, it is reasonably believed that the products of the reference would necessarily meet all the claimed characteristics governing the presently claimed copolymer. The onus is shifted to applicants to establish that the product of the present claims is not the same as or obvious from that set forth by the reference.

7. Claims 1-6, 14 and 15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 2003/0032767 (Tada et al).

Tada et al disclose polyester-amide fiber comprising an aliphatic polyamide unit and an aliphatic polyester unit. The polyesteramide copolymer should have a melting point of 100 C or higher and a relative viscosity of greater than 1.0.

Polyesteramides meeting the requirements of the present claims in terms of the types of polyester and polyamide components and molecular weight are embraced by the reference and

would have been immediately envisaged to one having ordinary skill in the art. Given the similarity in chemistry, molecular weights and preparatory processes, it is reasonably believed that the products of the reference would necessarily meet all the claimed characteristics governing the presently claimed copolymer. The onus is shifted to applicants to establish that the product of the present claims is not the same as or obvious from that set forth by the reference.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana L. Woodward whose telephone number is (571) 272-1082. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ana L. Woodward/

Primary Examiner
Art Unit 1796